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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,830	10/18/2001	Yawcheng Lo	82992PCW	7053
7590 Thomas H. Close Patent Legal Staff Eastman Kodak Company 343 State Street Rochester, NY 14650-2201			EXAMINER BEKIRMAN, MICHAEL	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 02/23/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/981,830

Applicant(s)

LO ET AL.

Examiner

MICHAEL BEKERMAN

Art Unit

3622

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14 and 17-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14 and 17-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

This action is responsive to papers filed on 11/07/2008.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. **Claims 18 and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 18 and 25, these claims recite the limitation "the storage medium comprises a printed storage medium". The specification lacks any definition for what a "printed storage medium" could comprise. While the specification has support for pre-printed or print-on-demand advertisements, printed matter is not considered to be a "storage medium".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 18 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claims 18 and 25, these claims recite the limitation "the storage medium comprises a printed storage medium". While the specification has support for pre-printed or print-on-demand advertisements, printed matter is not considered to be a "storage medium". Therefore, it is unclear as to what the Applicant is trying to claim by adding the limitation "printed" to "storage medium". For the purpose of applying prior art, a digital storage medium that has data imprinted thereon is believed to read over a "printed storage medium".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 14 and 17-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ko (U.S. Pub No. 2001/0044742) in view of King (U.S. Pub No. 2002/0055373), and further in view of Lipson (U.S. Patent No. 5,963,670).**

Regarding claims 14, 17, 19, 20, 22, 24, 26, and 28, Ko teaches extracting information from content on a disc (date/time information) (Paragraph 0035), correlating the extracted information to pre-determined advertisements (checking for updates based on the extracted date/time information) (Paragraphs 0039 and 0040), and placing the correlated advertisement on the disc (Paragraph 0041). The time information that is extracted from the disk is information related to the use of an electronic device. The computer taught by Ko in the cited sections is considered to be a kiosk computer.

While Ko teaches determining appropriate advertisements based on content extracted from the disc, Ko does not appear to specify extracting specific image content. King teaches a method of matching advertisements (services such as “vacation opportunities”) to specific content information associated with picture files (Paragraphs 0030 and 0038). To match a vacation opportunity to an image, there must inherently be some form of classification performed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to target advertisements based on any information that could be extracted from the disc of Ko, including the type of information taught by King. This would allow for better reception of the advertisement by the user.

While King teaches targeting advertisements based on information associated with images, neither Ko nor King appear to specify computer-analyzing images to receive such specific image content. Lipson teaches a method of computer-analyzing images to extract scene classification, face recognition, and biological motion (Column 2, Line 56 - Column 3, Line 17). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a computer to extract such information from images. Not only would this eliminate unneeded human error, but should there be no information provided with an image in the system of King, information could be extracted and provided on the spot.

Regarding claims 23 and 29, the following is a definition for the term meta-data from Merriam-Webster online dictionary:

Main Entry: meta-da-ta ¶¶
Pronunciation: \-'dā-tə, -'da- <i>also</i> -'dā-\
Function: <i>noun plural but singular or plural in construction</i>
Date: 1983
: data that provides information about other data

Once information is extracted, that information is inherently meta-data as it is data that provides information about other data.

Regarding claims 21 and 27, Ko teaches image, video, and audio advertisements (Paragraphs 0031 and 0032).

Regarding claims 18 and 25, Ko teaches imprinting data onto a disc. When a disc is imprinted with information, Examiner considers this to be a "printed storage medium".

Response to Arguments

4. Applicant argues "it has been long established that an applicant may be his own lexicographer in establishing the meaning of terms". While this is true, Applicant's specification has no definition for the term "printed storage medium". While Applicant is indeed allowed to define terminology to be used in the application, this is limited to definitions available in the specification at the time of filing. Otherwise, the terms will take on their standard definitions in the art. Examiner asserts that the term "printed storage medium" has no common definition in the art, and therefore remains unclear and undefined.

5. Applicant argues "the Examiner has failed to provide any specific reasoning in support of the rejection of claims 14 and 19" and "absent a specific showing as to why the combination of references would render the claimed kiosk obvious, the rejection is

improper and should be withdrawn". Examiner believes that the portions of claims 14 and 19 to which Applicant is referring involve the platform that receives the storage medium. In the rejection, Examiner stated "Ko teaches extracting information from content on a disc" and "The computer taught by Ko in the cited sections is considered to be a kiosk computer". Further, one of the sections cited for Ko in the rejection is Paragraph 0035, which states "the disc 106 is loaded into the user terminal". Examiner believes that it goes without saying that the loading of a disc into a computer requires a platform of some type, and that Ko has support for this. To further show that the kiosk of Ko has support for this feature, Paragraph 0030 recites "the user terminal 109 could be a computer having...an optical disc driving apparatus". Examiner would like to remind Applicant that they are not only responsible for the cited sections, but for the prior art of record in its entirety.

6. Further, the platform limitations in claims 14 and 19 are recited within wherein clauses. The following portions of the MPEP are relevant in regards to this type of claim language:

MPEP 2114 states:

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. A claim containing a "**recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus**" if the prior art apparatus teaches all the structural limitations of the claim.

MPEP 2106 (II) (C) states:

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. **Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.** The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "**wherein**" clauses, or
- (D) "whereby" clauses.

USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. **Limitations appearing in the specification but not recited in the claim should not be read into the claim.**

This is simply a notice to the Applicant that, while such limitations in the claims are not believed to have been ignored, such an argument holds little weight as a wherein clause does not function to actively limit the claim language.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MICHAEL BEKERMAN** whose telephone number is (571)272-3256. The examiner can normally be reached on Monday - Friday, 9:00 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. B./
Examiner, Art Unit 3622

/Eric W. Stamber/
Supervisory Patent Examiner, Art Unit 3622